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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,866	10/06/2000	David Allison Bennett	PSTM0038/MRK/STM	2836
29524 7590 03/31/2009 KHORSANDI PATENT LAW GROUP, A.L.C. 140 S. LAKE., SUITE 312 PASADENA, CA 91101-4710			EXAMINER PLUCINSKI, JAMISUE A	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 03/31/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/684,866	Applicant(s) BENNETT ET AL.	
	Examiner JAMISUE A. PLUCINSKI	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,30 and 54-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12,30 and 54-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20050228, 20080905, 20090123</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Requirement for Information under 37 CFR 1.105

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.
2. The applicant has provided the reference WO 99/33016 which is a 625 page document, and has not specified any of the relevant pages in the document. The applicant is requested to point to specific pages, sections and/or figures which are relevant to the claims, specifically to shipping carriers, choosing a carrier, inputting origin and destination addresses and calculating shipping. The applicant has supplied the reference as being relevant to the claimed invention, therefore a more clear understanding of what specifically the applicant considers to be relevant in the jumbo reference provided, is needed to make a more clear patentability determination.
3. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of the requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97 where appropriate.
4. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by

Art Unit: 3629

providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure. In response to this requirement, please provide a list of keywords that are particularly helpful in locating publications related to the disclosed art of cross purchase.

5. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

6. This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Election/Restrictions

7. Applicant's election without traverse of claims 12, 30 and 54-57 in the reply filed on 1/23/09 is acknowledged.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

a. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 12, 30 and 54-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3629

10. With respect to Claim 12: the claim discloses the use of a shipping management computer system that is programmed to perform a set of steps, yet it is unclear whether the claim is a system claim or a method claim. A system is considered to be an apparatus claim, yet the claim does not disclose any structure, therefore it is unclear what the structure is of the system that is performing or programmed to perform the steps outlined in the claim.

11. With respect to Claim 30: the claim discloses the use of a system comprising at least one computer device, and then further states that the computer system is programmed for performing method steps. Therefor it is unclear to the examiner what is actually being programmed to perform the method steps, is it the computer device or another part of the system that performs the method step.

Response to Amendment

12. The affidavit under 37 CFR 1.132 filed 9/5/08 is insufficient to overcome the rejection of claims 12 and 30 based upon Kara as set forth in the last Office action because:

13. The affidavit is filed by the CTO of the assignee of the case, therefore has a vested interest in the outcome of the application and therefore is not considered to be an unbiased party.

14. The person giving the affidavit states use in the shipping industry, yet never states any experience in reading and interpreting references and the affidavit sets out to interpret Kara, therefore the person making the affidavit would simply provide a simple opinion, which the examiner does not consider to be persuasive.

15. Furthermore, the affidavit does not address the claims as presently claimed in the invention. The applicant dramatically changed the claims, and the affidavit only gives an

Art Unit: 3629

overview of the claims and how Kara does not read on the overview, and does not address the newly added claim limitations.

16. The affidavit is considered to be moot, considering the below mentioned allowable subject matter. The affidavit has not served to obviate the claim rejection, rather the amendment to the claims have.

Allowable Subject Matter

17. Claims 12, 30 and 54-57 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action, as well as if the reply to the requirement for information including the relevant sections of the jumbo reference submitted in the IDS does not show the invention as claimed.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fields et al (7,454,356) discloses the use of a third party shipping coordinator where the vendor and the purchaser enter their addresses separately.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

Art Unit: 3629

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629